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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,957	12/18/2001	Wayne M. Doran	9852.00	7152

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EXAMINER


WINTER, JOHN M

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/022,957	DORAN, WAYNE M.	
	<b>Examiner</b>	<b>Art Unit</b>	
	John M Winter	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 December 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/23/2002</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

Claims 1-16 are pending.

### *Claim Rejections - 35 USC §101*

Claims 1-9 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claim 1 only recites an abstract idea. The recited steps of merely obtaining, over a communication link, a request for a certified check; verifying that issuance of the check is authorized under law; and issuing a validation number for the check. does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to facilitate a transaction.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention allows obtaining a request for a certified check (i.e., repeatable) a issuing a validation number for said check (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claim 1 is deemed to be directed to non-statutory subject matter.

All that is necessary to make a sequence of operational steps in a statutory process within 35 U.S.C. 101 is that it be in the technological arts so as to be in concordance with the Constitutional purpose to promote the progress of "useful arts" *In re Musgrave*, 431 F.2d 882 167 USPQ 280 (CCPA 1970)

A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result: i.e. the method recites a step or act of producing something that is concrete, tangible and useful. *See AT&T v. Excel Communications Inc.*, 172 F3d at 1358, 50 USPQ2dat 1452.

Claims 2-9 are dependant on claim 1 and are rejected for at least the same reasons.

### *Claim Rejections - 35 USC § 103*

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1- 13 are rejected under 35 U.S.C. 102(e) as being unpatentable over Chang et al. (US Patent 5,884,288) in view of Bozeman (US Patent 6,754,640).

As per claim 1,

Chang et al. ('288) discloses a method of operating a financial institution, comprising: obtaining, over a communication link, a request for a certified check;(Figure 8B) issuing a validation number for the check.(Column 8, lines 4-12)

Chang et al. ('288) does not explicitly disclose verifying that issuance of the check is authorized under law. Bozeman ('640) discloses verifying that issuance of the check is authorized under law. (Figure 5B) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Chang et al. ('288). method with the Bozeman ('640) method in order to prevent illegal transactions from occurring.

As per claim 2,

Chang et al. ('288) discloses a method according to claim 1, wherein the request identifies a specific bank account.(Figure 5B)

As per claim 3,

Chang et al. ('288) discloses a method according to claim 1, wherein the communication link comprises the Internet.(Column 5, lines 22-34)

As per claim 4,

Chang et al. ('288) discloses a method according to claim 1, wherein the process of verifying comprises verifying that the request was made by a party authorized to write checks on the specific account.:(Column 6, lines 62-67- column 7, lines 1-8)

As per claim 5,

Chang et al. ('288) discloses a method according to claim 4, wherein the process of verifying further comprises verifying that the specific account contains funds sufficient to cover the check.(Figure 7)

As per claim 6,

Chang et al. ('288) discloses a method according to claim 1, wherein the validation number did not exist on the check prior to the request.(Column 8, lines 4-12)

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As per claim 7,

Chang et al. ('288) discloses a method according to claim 1, wherein the certified check contains the following information: date; account number of the specific account; and symbols identifying a drawee bank which maintains custody of the specific account (Column 7, lines 47-56)

Official Notice is taken that "including a Uniform Resource Locator, URL" is common and well known in prior art in reference to network transactions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a URL in order to provide the payee with a reference to the payors bank.

As per claim 8,

Chang et al. ('288) discloses a method according to claim 1, and further comprising: deriving a validation number for the certified check. (Column 8, lines 4-12)

As per claim 9,

Chang et al. ('288) discloses a method according to claim 8, and further comprising: applying symbols to the certified check which indicate the validation number.(Column 8, lines 4-12)

As per claim 10,

Chang et al. ('288) discloses a method comprising:  
receiving from a party over the Internet a request for a certified check and a monetary amount of the check;(Figure 8B)  
issuing a validation number for the check.(Column 8, lines 4-12)  
ascertaining whether an account of the party contains funds sufficient to cover the certified check and, if so, listing over the Internet a validation number to the party.(Figure 7)

Chang et al. ('288) does not explicitly disclose authenticating identity of the party. Bozeman ('640) discloses authenticating identity of the party. (Figure 5B) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Chang et al. ('288). method with the Bozeman ('640) method in order to prevent illegal transactions from occurring.

As per claim 11,

Chang et al. ('288) discloses the method according to claim 10,  
Official Notice is taken that "receiving one or more inquiries which present numbers, and if a number conforms to the validation number, issuing a confirmation" is common and well known in prior art in reference to network transactions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to confirm a transaction in order to allow the payee to know that a transaction is pending.

As per claim 12,

Chang et al. ('288) discloses the method according to claim 11,  
in which the inquiries are received in an Internet communication. (Figure 2)

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As per claim 13,

As per claim 13,

Chang et al. ('288) discloses the method according to claim 11,  
in which the confirmation is issued in an Internet communication.(Figure 2)

Claims 14-16 are rejected under 35 U.S.C. 102(e) as being unpatentable over Chang et al.  
(US Patent 5,884,288)

As per claim 14,

Chang et al. ('288) discloses a system, comprising:

means for receiving, from a requestor, a request over the Internet for issuance of a  
certified check;(Figure 8B)

means for establishing a reference character sequence for the check;(Column 8, lines 4-  
12)

means receiving a proposed character sequence over the Internet and,  
if the proposed character sequence matches the reference character sequence, issuing a  
confirmation signal.(Figure 7)

means for transmitting the reference character sequence to the  
requestor over the Internet; (Figure 7)

As per claim 15,

Chang et al. ('288) discloses a system according to claim 14,  
wherein a web site receives the proposed character sequence.(Figure 2)

As per claim 16,

Chang et al. ('288) discloses a system according to claim 15,  
wherein the web site issued the confirmation signal.(Figure 2)

### ***Conclusion***

Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Winter whose telephone number is (703) 305-3971. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

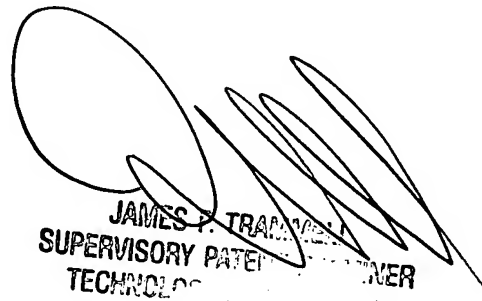
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (703)305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (763) 872-9306 for regular communications and (763) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

JMW

August 22, 2004

  
JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGICAL CENTER